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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,031	10/24/2005	Josef Laumen	071308.0974	9038
31625 7590 12/08/2008 BAKER BOTTS L.L.P. PATENT DEPARTMENT 98 SAN JACINTO BLVD., SUITE 1500 AUSTIN, TX 78701-4039			EXAMINER BROOKS, SHANNON	
			ART UNIT 2617	PAPER NUMBER
			MAIL DATE 12/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,031

Applicant(s)

LAUMEN ET AL.

Examiner

SHANNON R. BROOKS

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 27-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 9/16/08 have been fully considered but they are not persuasive.

The argued features, i.e., “communicating a user identification message from the user identification circuit to the telecommunication device”; “transmitting at least one service request message over the radio communication network from the user identification circuit to a service computer, wherein the at least one service request message requests allocation of at least one service”; “receiving a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message, wherein the user identification circuit evaluates the pre-paid account status message”; “communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result”.

Lehmus is discussing a subscriber identity module that makes it possible to integrate different smart card functions with the SIM card used in a mobile station. The system enables new diversified service combinations to be implemented so as to allow them to be utilized via a data communication device, such as a mobile station. A feature characteristic of these service combinations is that a part of the series of actions is carried out in a system and/or application external to the data communication system and the data communication device in addition to or instead of wireless communication between the mobile station and the data communication

system/application. Lehmus is discussing a subscriber identification module that contains an IMSI code that sends messages to a telecommunications device. Therefore, Lehmus clearly reads on the argued limitation of “communicating a user identification message from the user identification circuit to the telecommunication device.” Lehmus discusses a system that enables new diversified service combinations using SMS or USSD messages transmitted from a user identification circuit to a computer. Therefore, Lehmus clearly reads on the argued limitation of “transmitting at least one service request message over the radio communication network from the user identification circuit to a service computer, wherein the at least one service request message requests allocation of at least one service.” Lehmus discusses a SIM card receiving a message containing information about a sum to be debited. The application in the SIM device requires approval of the debiting message by the user before the message is forwarded to a server that verifies creditworthiness. Therefore, Lehmus clearly reads on the argued limitation of “receiving a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message, wherein the user identification circuit evaluates the pre-paid account status message.” As previously discussed a SIM card receiving a message containing information about a sum to be debited. The application in the SIM device requires approval of the debiting message by the user before the message is forwarded to a server that verifies creditworthiness. Since the SIM card requires approval of debit amount by the user, a transfer of an evaluated prepaid account status from the SIM card to the telecommunication device is taught. Therefore, Lehmus clearly reads on the argued limitation of “communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested

service when the evaluated pre-paid account status message indicates a specific result". The Applicant argues that Silva does not teach a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device. However, the Examiner has actually argued that Lehmus in combination with Sivula teaches a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device. The combination teaches a SIM card receiving a message containing information about a sum to be debited. The application in the SIM device requires approval of the debiting message by the user before the message is forwarded to a server that verifies creditworthiness. Therefore, the combination clearly reads on "a transfer of an evaluated pre-paid account status from the SIM card to the telecommunication device". The Applicant argues that independent claims 27 and 39, which contain similar limitations, as well as their dependent claims should be allowed. However, the Examiner has argued these limitations and therefore, respectfully disagrees. Further, Lehmus and Sivula are exemplary references from relevant subclasses that read upon the argued limitations as discussed above and as set forth in the following office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. **Claim 27-33 and 39-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmus in view of Sivula (US 6907239 B1).

Consider **Claim 27**, Lehmus teaches a method for providing pre-paid services over a radio communication network to a telecommunication device comprising a user identification circuit, the method comprising the steps of: communicating a user identification message from the user identification circuit to the telecommunication device, (Fig. 4c, Pg. 10, lines 10-17); transmitting at least one service request message over the radio communication network from the user identification circuit to a service computer, wherein the at least one service request message requests allocation of at least one service (read as SMS or USSD message, Fig. 4c, Block 41 and Pg. 10, lines 29-37, and Pg. 11, lines 1-19); receiving a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message, wherein the user identification circuit evaluates the pre-paid account status message (read as server verifies user's creditworthiness so that prepaid card can be debited, Pg. 10, line 29-Pg. 11, line 13); except that Lehmus does not specifically teach communicating the evaluated pre-paid account status message from the user identification

circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result.

However, Silvula clearly teaches communicating the evaluated pre-paid account status message from the user identification circuit to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result (Col. 1, line 46-Col. 2, line 11, Col. 3, lines 49-56, and Col. 7, lines 14-17).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to incorporate the teachings of Siva into Lehmus in order to aid in determining the remaining value in an account (Col. 7, lines 14-17).

Consider **Claim 39**, Lehmus teaches an apparatus that allocates pre-paid services over a radio communication network, comprising:
a telecommunication device (Figs. 1-3); and a user identification circuit, wherein the user identification circuit communicates a user identification message to the telecommunication device (Pg. 10, lines 11-17)), and transmits at least one service request message over the radio communication network to a service computer, wherein the at least one service request message requests allocation of at least one service (Pg. 10, lines 29-37 and Pg. 11, lines 1-19), and wherein the user identification circuit receives a pre-paid account status message over the radio communication network from the service computer to the user identification circuit in response to each service request message (read as server allows or denies service, Pg. 10, line 29-Pg. 11, line 19), wherein the user identification circuit evaluates the pre-paid account status message (Pg. 10, line 29-Pg. 11, line 19), except that Lehmus does not specifically teach wherein the user identification circuit communicates the evaluated pre-paid account status message to the

telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result.

However, Silvula teaches wherein the user identification circuit communicates the evaluated pre-paid account status message to the telecommunication device to allocate use of the requested service when the evaluated pre-paid account status message indicates a specific result (Col. 1, line 46-Col. 2, line 11, Col. 3, lines 49-56, and Col. 7, lines 14-17).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to incorporate the teachings of Siva into Lehmus in order to aid in determining the remaining value in an account (Col. 7, lines 14-17).

Consider **Claim 28**, Lehmus teaches the method, wherein the telecommunication device is one of a GSM device and a UMTS device (Pg. 1, lines 24 and 26, Fig. 2, and Pg. 9, lines 3 and 20)).

Consider **Claim 29**, Lehmus teaches the method, wherein the user identification circuit is one of a Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (Figs. 1-3, Pg. 4, line 17-Pg. 5, line 15).

Consider **Claim 30**, Lehmus teaches the method, wherein the service request message is generated by a command set on an application toolkit stored in one of the Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) (Pg. 10, line 29-Pg. 11, line 4).

Consider **Claim 31**, Lehmus teaches the method, wherein the at least one service request message is transmitted concurrently with the communication of the user identification message (Pg. 10, line 29-Pg. 11, line 19).

Consider **Claim 32**, Lehmus teaches the method, wherein the specific result is an indication that sufficient pre-paid credit is available (Pg. 10, line 29-Pg. 11, line 19).

Consider **Claim 33**, Lehmus teaches the method, but Lehmus fails to specifically teach the method wherein the service is at least one of mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service.

However, Sivula teaches the method wherein the service is at least one of mobile email, instant messaging, video telephony, a multimedia messaging service and a short message service (Col. 6, lines 58-67).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus and Sivula in order to convey a list of services (Col. 6, line 61).

Consider **Claim 37**, Lehmus teaches the method, further comprising the step of blocking allocation (read as denying access) of the requested service if the evaluated pre-paid account status message does not indicate the specific result (Pg. 10, line 29-Pg. 11, line 19).

Consider **Claim 38**, Lehmus teaches the method, wherein the service computer is a server (Fig. 3, and Pg. 9, line 9-Pg. 10, line 10).

Consider **Claim 40**, Lehmus teaches the apparatus, wherein the telecommunication device is one of a GSM device and a UMTS device (Pg. 1, lines 24 and 26, Fig. 2, and Pg. 9, lines 3 and 20).

Consider **Claim 41**, Lehmus teaches the apparatus, wherein the user

identification circuit is one of a Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM)) (Figs. 1-3, Pg. 4, line 17-Pg. 5, line 15).

Consider **Claim 42**, Lehmus teaches the apparatus wherein the service request message is generated by a command set on an application toolkit stored in one of the Subscriber Identity Module (SIM) and a UMTS Subscriber Identity Module (USIM) (Pg. 10, line 29-Pg. 11, line 14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. **Claim 34-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lehmus in view of Sivula (US 6907239 B1) and further in view of Capitani (US 6967011 B1).

Consider **Claim 34**, Lehmus and Silvula teach the method, but the combination fails to specifically teach the method wherein and the at least one service request message contains, depending upon a type of requested service, additional data required for providing the service.

However, Capitant teaches the method wherein and the at least one service request message contains, depending upon a type of requested service, additional data required for providing the service (read as buyer's authentication, Col. 3, lines 44-57).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus and Silvula with Capitant in order to aid in security (Col. 3, lines 44-57).

Consider **Claim 35**, Lehmus, Silvula, and Capitant teach the method, but fail to specifically teach wherein each service request message includes parameters for charges, depending on the type of service being requested (read as determining creditworthiness.

However, Lehmus teaches wherein each service request message includes parameters for charges, depending on the type of service being requested (read as determining creditworthiness, (Pg. 10, line 29-Pg. 11, line 4).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to incorporate the teachings of Lehmus, Sivula, and Capitant with further teachings of Lehmus to aid in applying application toolkit parameters (Pg. 10, line 29-Pg. 11, line 4).

Consider **Claim 36**, Lehmus, Sivula, and Capitant teaches the method, but the combination fails to specifically teach the method wherein the at least one service request message describes an order of the services requested by the radio communication terminal.

However, Sivula teaches the method wherein the at least one service request message describes an order of the services requested by the radio communication terminal (Col. 6, lines 17-44).

Therefore, it would have been obvious to one skilled in the art at the time of the invention to combine the teaching of Lehmus, Capitani, and Sivula with further teachings of Sivulain order to aid in item selection (Col. 6, lines 17-44).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to:**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be brought to

Customer Service Window
Randolph Building
401 Dulany Street

Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shannon Brooks whose telephone number is (571) 270-1115. The examiner can normally be reached on 7:30a.m. to 5p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Corsaro can be reached on (571) 272-7876. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/customer service whose telephone number is (571) 272-2600.

Art Unit: 2617

/Shannon R. Brooks/

Examiner, Art Unit 2617

Shannon Brooks

December 3, 2008

/NICK CORSARO/

Supervisory Patent Examiner, Art Unit 2617